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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DWIP N. BANERJEE, RABINDRANATH DUTTA,  
and KAMAL CHANDRAKANT PATEL

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Appeal 2007-2319  
Application 09/915,436  
Technology Center 3600

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Decided: January 8, 2008

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Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and DAVID B. WALKER, *Administrative Patent Judges*.

WALKER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1-26. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm-in-part.

### THE INVENTION

Appellants claim a method, apparatus, and computer implementable instructions for insuring delivery of electronic documents in a network data processing system (Specification 1:8-11). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A method in a data processing system for insuring delivery of an electronic document, the method comprising:

receiving a request from a requestor to insure delivery of the electronic document;

responsive to receiving the request, identifying a payment amount to insure delivery based on network characteristics of a network in which the electronic document is to be transmitted to form an identified payment amount;

sending an acknowledgment of the electronic document to the requestor, wherein the acknowledgment includes the identified payment amount; and

delivering the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

McCabe	US 2002/0095317 A1	Jul. 18, 2002
Cianciarulo	US 2005/0027849 A1	Feb. 3, 2005

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Claims 1-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cianciarulo in view of McCabe.

### ISSUE

The issue before us is whether Appellants have shown that the Examiner erred in rejecting claims 1-26 as unpatentable over Cianciarulo in view of McCabe. The dispositive issue is whether the Examiner has made a *prima facie* case of obviousness of claims 1-26 over Cianciarulo in view of McCabe.

Rather than repeat the arguments of Appellants and the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

### FINDINGS OF FACT

We find the following enumerated findings to be supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Cianciarulo teaches systems and methods for insuring, bonding, and underwriting a transmission of a data set, streaming data, and/or document over the Internet (Cianciarulo, Abstract).

2. In a method embodiment, the transmission of the document is a permission activated event. Once a user at a remote client submits data representing the electronic data set, streaming data, and/or document to be transmitted to another remote means, the transmission is authorized and the software means, or program provides the selected coverage and selected coverage amount and assesses or charges a fee to an appropriate account upon transmission of the data set, streaming data, and/or document. The software means will generate a delivery verification and electronically provide the delivery verification to the sending user/remote client over the communication network (Cianciarulo, 10:[0064]).
3. Cianciarulo does not teach “delivering the electronic document in response to receiving a reply to the acknowledgement from the requestor accepting the identified payment amount.”
4. In one embodiment, Cianciarulo maintains at least one database that maintains a data structure against which all transmission can be verified as transmitted and received or not received (Cianciarulo, 6:[0041]). Cianciarulo defines the insuring of electronic documents as including providing an insurance coverage amount payable in the event that data, streaming data, and documents transmitted from one remote client to another remote client is not received, e.g., the transmission fails (Cianciarulo, 6:[0044]).
5. McCabe teaches methods for insurance of online presence and/or data (McCabe, Abstract). One method comprises the steps of providing the

insured entity with the technical data protection services pursuant to the agreement, and providing the insurer electronically with a report on the status of such provision of services (McCabe, 2:[0024]). Another method is for providing data insurance based on data mirroring services, and comprises the steps of an insurer calculating an insurance premium for a data insurance policy; and the insurer contracting to provide data insurance under the policy to an insured entity subject to the use of technical data protection services. Depending on the embodiment, the calculating step factors in information such as: an expected result of virus scanning to be performed on the data as a technical data protection service, an expected data recovery period, an expected geographic dispersion of data which is backed up by a technical data protection service, and/or an expected technical data protection service employing multiple methods of data recovery (McCabe, 2:[0025]).

6. A generally accepted principal of insurance is that each insured, and each class of insureds, should bear a mathematically fair share of the insurance pool's losses and expenses. Simply put, the mathematically fair price for insurance is found by multiplying the probability of loss for the class times the dollar value exposed to loss, then adding a fair share of the insurer's expenses. McCabe teaches that the above risk classification techniques are developed by observing defined events across large groups of people or entities, which does not necessarily work effectively with data and online presence. In the traditional business world, a

business is expected to do business at a somewhat predictable rate, with predictable markets and relatively easily determined expenses; in the e-commerce economy this is often not the case (McCabe, 4:[0061-0062]).

7. McCabe teaches that, in some embodiments, the underwriter monitors data activity at the insured site, in real-time or near-real-time, and dynamically adjusts the insurance coverage costs and/or coverage in direct response to changes in the monitored activity (McCabe, 4:[0131]).
8. McCabe does not teach “delivering the electronic document in response to receiving a reply to the acknowledgement from the requestor accepting the identified payment amount.”

#### PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of ordinary skill in the art, and (4)

where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”).

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Id.* at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

## ANALYSIS

Appellants argue, with respect to Claim 1, that none of the cited references teach or suggest the claimed feature of "delivering the electronic document *in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount*" (Br. 13). The Examiner found that the teaching of a permission activated event in Cianciarulo represents Appellants' acknowledgement of the payment amount (appropriate fee) (Answer 4). We disagree.

Although the cited passage of Cianciarulo (Cianciarulo, 10:[0064]) teaches that the transmission is authorized and the software means, or program, provides

the selected coverage and selected coverage amount, and assesses or charges a fee to an appropriate account upon transmission of the data set, streaming data, and/or document (Finding of Fact 2), it does not teach delivering the electronic document in response to receiving a reply to the acknowledgment from the requestor accepting the identified payment amount (Finding of Fact 3). McCabe also fails to teach this missing limitation (Finding of Fact 8). Because neither of the asserted references teaches the missing delivery in response to receiving the claimed reply from the requestor, the Examiner failed to make out a *prima facie* case of obviousness as to independent claims 1, 13, 15, and 25. Dependent claims 2-7 and 16-21 therefore are nonobvious as depending from a nonobvious independent claim. See *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988). (If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim dependent therefrom is nonobvious).

With respect to Claim 8, Appellants argue that none of the cited references teach or otherwise suggest analyzing the electronic document to identify an estimated amount of time in which the electronic document can be delivered (Br. 16). In particular, “Appellants urge that determining/proving that a document was delivered or not (an ‘after the fact’ occurrence with respect to delivery) is a totally different concept from using an estimated amount of time in which a document can be delivered (a ‘before the fact’ occurrence with respect to delivery).” (*Id.*). We agree with Appellants that claim language “analyzing the electronic document to identify an estimated amount of time in which the document *can be delivered*” is prospective. While Cianciarulo teaches providing an insurance coverage amount

payable in the event that transmission of data, streaming data, and/or documents fails, we find no teaching in either of the asserted references of analyzing the electronic document to identify an estimated time of delivery as required by claim 8. The Examiner thus failed to make out a *prima facie* case of obviousness as to claim 8.

With respect to claim 12, Appellants contend that neither of the cited references teaches or suggests “providing an insurance cost and an estimated time of delivery for the electronic document.” (Br. 19). The Examiner found that Cianciarulo teaches “timely delivery” and that, in order to determine if a transmission is timely, there necessarily has to be an estimated time of delivery (Answer 19). We disagree. As stated *supra* with respect to claim 8, we find no teaching in either of the asserted references of providing an estimated time of delivery as required by claim 12. The Examiner thus failed to make out a *prima facie* case of obviousness as to claim 12.

With respect to claim 9, Appellants argue that none of the cited references teach or suggest an insurance payment that is based on at least one of network traffic characteristics, network congestion, reliability properties of the network, and statistical transmittives of the network (Br. 17). The Examiner found that McCabe teaches determining the probability for loss based on statistics associated with the thing being insured and cited paragraphs 0061-0062 as a supporting example (Answer 17). Appellants argue that the cited passage of McCabe teaches traditional classification risks that are likely not to be appropriate for use in an environment such as that recited in claim 9, and makes no mention of any type of

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network characteristic—either those expressly recited in claim 9, or otherwise—that is used in determining a payment amount for document insurance of delivery of such document using this same network (Br. 17-18). We disagree.

McCabe teaches embodiments in which the payment amount may be based on an expected result of virus scanning to be performed on the data as a technical data protection service, an expected data recovery period, an expected geographic dispersion of data which is backed up by a technical data protection service, and/or an expected technical data protection service employing multiple methods of data recovery (Finding of Fact 5). Because each of these factors considered by McCabe in determining the payment amount are network characteristics, functions of network congestion, or reliability properties of the network, Appellants have not shown that the Examiner erred in rejecting claim 9 as unpatentable over Cianciarulo in view of McCabe. Claims 10-11, 14, 22-24, and 26 were not argued separately, and fall with claim 9. See 37 C.F.R. § 41.37(c)(1)(vii). See also *In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

## CONCLUSIONS

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1-8, 12-13, 15-21, and 25 under 35 U.S.C. § 103(a). We conclude that Appellants have not shown that the Examiner erred in rejecting claims 9-11, 14, 22-24, and 26 under 35 U.S.C. § 103(a).

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DECISION

The decision of the Examiner to reject claims 1-8, 12-13, 15-21, and 25 under 35 U.S.C. § 103(a) is reversed. The decision of the Examiner to reject claims 9-11, 14, 22-24, and 26 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED-IN-PART

jlb

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